

Patent
Attorney's Docket No. 003780-060

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Ulrich GERBER et al) Group Art Unit: 1625
Application No.: 09/916,485) Examiner: Taylor V. OH
Filed: July 30, 2001)
For: POLYHYDROXYL-COMPOSITIONS)
DERIVED FROM CASTOR OIL)
WITH ENHANCED REACTIVITY)
SUITABLE FOR POLYURETHANE-)
SYNTHESIS)

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a response to the Official Action issued October 1, 2002, concerning the subject application.

In the Action, the Examiner required a restriction between (i) claims 1-8 and 10-17 directed to polyester polyols and methods of producing polyester polyols (Group I), and (ii) claim 9 directed to polyurethane coatings (Group II). In accordance with the requirement, applicants elect the claims of Group I directed to the polyester polyols and methods of producing polyester polyols (i.e., claims 1-8 and 10-17). This election, however, is made with traverse.

According to MPEP §803, no restriction requirement should ever be made unless there is a serious burden on the Examiner to examine all the claims in a single application. This is true even when other proper grounds for restriction exist. Here, the subject matter of

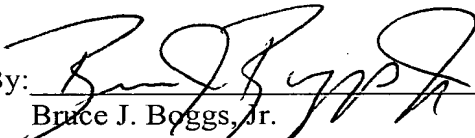
the identified groups of claims are so closely related that their respective searches are coextensive. In fact, the search required for the Group II claim necessarily includes the search for the Group I claims. The Group II claim depends from a Group I claim and specifically requires consideration of the polyols claim 1.

Accordingly, there is clearly absent an undue burden on the Examiner to examine all the claims in a single application. Therefore, it is submitted that the restriction requirement is improper and should be withdrawn.

Respectfully submitted,

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Date: October 31, 2002

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